



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------------|
| 10/786,169 | 02/26/2004 | Andreas Hayden | 080437.53242US | 3465 |
| 23911 7590 10/31/2007 CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300 | | | EXAMINER TO, TUAN C | |
| | | | ART UNIT 3663 | PAPER NUMBER |
| | | | MAIL DATE 10/31/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/786,169 | HAYDEN, ANDREAS | |
| | Examiner | Art Unit | |
| | Tuan C. To | 3663 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-18, 20 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13, 15-18, 20 and 26-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 8, 15-18, 20, and 26-32 are rejected under 35 U.S.C. 102 (b) as being anticipated by Ishiguro et al. (US 5949375A).

Regarding claims 8, and 15, Ishiguro et al. teaches a navigation system/method in which the program instructions are read out of a data carrier which is the CD-ROM, a ROM, a DVD, a floppy disk or the like (Ishiguro et al., figure 1; column 10, lines 4-10, programs instructions stored in the data carrier such as CD-ROM, DVD are read out by the present calculating apparatus 4); causing the system controller (4) (see figure 1) stores in the memory RAM (8) various data including route data, the ROM (7) stores control programs); accessing, by the storing or updating system, vehicle characterizing data (see figure 1, column 13, lines 29-47, the vehicle position data is accessed via the GPS receiver 3); the data stored on the data carrier such as CD-ROM, DVD, has been read out, wherein the stored data includes map data, control programs, etc (Ishiguro et al., column 12, lines 25-34).

Regarding claim 16, Ishiguro et al. teaches a method of inputting control unit data into a control unit in a vehicle comprising: reading by a reader unit, the control unit data out of a data carrier (Ishiguro et al., figure 1; column 10, lines 4-10, programs instructions stored in the data carrier such as CD-ROM, DVD are read out by the present calculating apparatus 4), communicating the program instructions to the unit (4) via the data bus (9), storing the program instructions in a memory associated with the unit (4) (Ishiguro et al., figure 1, ROM 7, RAM 8). It is noted that the program instructions disclosed in Ishiguro et al. is a computer program instructions therefore they should be program code for sequence control.

Ishiguro et al. further teaches that data carrier contains control unit data (program instructions) applicable to a plurality of vehicles, and said act of reading is controlled by a microprocessor which reads vehicle characterizing information from a memory, and causes said reader unit to read from said carrier, only control unit data that are applicable to particular vehicle control units (Ishiguro et al., figure 1, the program instructions stored in the data carrier CD-ROM or DVD is read out via the CD-ROM drive (11) and are processed by the computer (4), and that the computer (4) coupled to ROM and RAM from which the vehicle characterizing data is read out).

As to claim 17, Ishiguro et al. teaches the on-board navigation system (Ishiguro et al., abstract).

As to claim 18, Ishiguro et al. teaches that data carrier comprises CD-ROM, DVD.

As to claim 20, Ishiguro et al. further teaches: "characterizing information is stored in a memory maintained by a manufacturer of the vehicle (Ishiguro et al., column 12, lines 41-47, the ROM (7) is a volatile memory originally stores control program which is originally maintained by a manufacturer of the vehicle).

As to claims 26, and 28, Ishiguro et al. further teaches "the vehicle characterizing data characterizes a particular vehicle or vehicle type" (see column 12, lines 25-34, CD-ROM drive access the vehicle map data by reading the data stored on the CD-ROM disk DK).

As to claims 27, and 29, Ishiguro et al. discloses that the control unit (4) is coupled to ROM that stores a control program for control the performance of the navigation system.

Regarding claims 30-32, Ishiguro et al. teaches A method of inputting control unit data into a control unit in a vehicle, said method comprising the acts of: receiving, by a reader unit of a system on-board of the vehicle (figure 1, CD-ROM drive 11), a data carrier (figure 1, CD-ROM DK), wherein the data carrier includes control unit data applicable to a plurality of vehicles and storing or updating instructions for controlling storing or updating of a control unit by a microprocessor (figure 1, column 12, lines 25-34, the CD-ROM includes map data applied for a plurality of vehicle, and control programs for controlling storing or updating of the system controller 4); reading, by the reader unit (11), the storing or updating instructions and control unit data applicable to one of the plurality of vehicles (figure 1); and storing, by the microprocessor based on the storing instructions, the control unit data in a memory of

Art Unit: 3663

the control unit, or updating, by the microprocessor based on the updating instructions, the control unit data in the memory of the control unit (column 12, lines 25-34, the data stored on the data carrier such as CD-ROM, DVD, has been read out, wherein the stored data includes map data, control programs, etc).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiguro et al. (US 5949375A) and in view of Brody (US 20010051928A1).

Ishiguro et al teaches the limitations of claim 8 except for "the control unit data stored on the data carrier is encrypted, the control unit data is protected against falsification". Brody teaches that the software stored on the data carrier such as CD-

ROM is encrypted, the software is protected against falsification (Brody, paragraph 0013).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system/method as taught by Ishiguro et al. to include the teachings of Brody in order to protect the software from unauthorized copying and distribution.

Response to Arguments

Applicant's arguments filed 08/16/2007 have been fully considered but they are not persuasive. The present application has been set in a condition of final rejection for the reason that the cited reference identically discloses every limitation of the claims.

The applicant traverses the previous rejection because the cited reference to Ishiguro fails to disclose a storing or updating system accessing "vehicle characterizing data", "reading out...control unit data for a vehicle indicated by the vehicle characterizing data or for its control unit." The applicant further argued that Ishiguro fails to disclose that the control unit data is read out "from a plurality of control unit data stored on the data carrier."

It is not persuasive because the following:

As to claim 8, Ishiguro et al. teaches a system/method for calculating position of movable body in navigation system including storing and updating control unit data via the system controller (4) (see column 13, lines 13-24). Ishiguro identically discloses the limitation: "accessing, by the storing or updating system, vehicle characterizing data" (figure 1, column 13, lines 29-47, the vehicle position data is accessed via the GPS

Art Unit: 3663

receiver 3). The vehicle map data stored on the CD-ROM disk DK is read out by the CD-ROM drive (11) under the control of the system controller (4) (column 12, lines 25-34). Thus, Ishiguro et al. also teaches "reading out...control unit data for a vehicle indicated by the vehicle characterizing data or for its control unit."

As to claim 15, the examiner believe the cited reference to Ishiguro teaches the limitation of the claim including the limitation "wherein said carrier contains control unit data applicable to a plurality of vehicles, and said act of reading is controlled by a microprocessor which reads vehicle characterizing information from a memory, and causes said reader unit to read from said carrier only control unit data that are applicable to particular vehicle control units" (Ishiguro et al., figure 1, the program instructions stored in the data carrier CD-ROM or DVD is read out via the CD-ROM drive (11) and are processed by the computer (4), and that the computer (4) coupled to ROM and RAM from which the vehicle characterizing data is read out).

As to claims 9-13, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the cited reference to Ishiguro is modified to include the teaching of Brody in order to protect the software from unauthorized copying and distribution.

As for the same reasons above, the new claims 26-32 would not be patentable over the cited prior art.

Conclusions

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

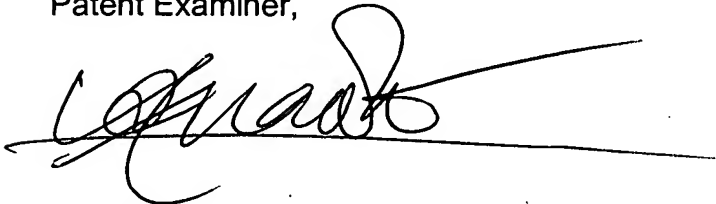
Art Unit: 3663

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner,

A handwritten signature in black ink, appearing to read 'Tuan C To', is written over a horizontal line.

Tuan C To

June 21, 2007